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## BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of:	:	Before the Examiner:
Vincent C. Conzola	:	Daniel A. Hess
	:	
Serial No.: 10/776,112	:	Group Art Unit: 2876
	:	
Filing Date: February 11, 2004	:	
	:	IBM Corporation
Title: PRODUCT CHECKOUT	:	P.O. Box 12195
SYSTEM WITH ANTI-THEFT	:	Dept. 9CCA, Bldg. 002-2
DEVICE	:	Research Triangle Park, NC 27709

**SECOND APPEAL BRIEF**

Mail Stop Appeal Brief-Patents  
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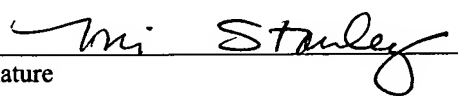
**I. REAL PARTY IN INTEREST**

The real party in interest is International Business Machines, Inc., which is the assignee of the entire right, title and interest in the above-identified patent application.

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**CERTIFICATION UNDER 37 C.F.R. §1.8**

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to Mail Stop Appeal Brief-Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450, on January 27, 2006.

  
SignatureToni Stanley

(Printed name of person certifying)

## II. RELATED APPEALS AND INTERFERENCES

There are no other appeals or interferences known to Appellant, Appellant's legal representative or assignee which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

## III. STATUS OF CLAIMS

Claims 9-17 and 24-32 are pending in the Application. Claims 9-17 and 24-32 stand rejected. Claims 9-17 and 24-32 are appealed.

## IV. STATUS OF AMENDMENTS

No amendments were filed subsequent to the final rejection.

## V. SUMMARY OF CLAIMED SUBJECT MATTER

### *Independent Claim 9*

Independent claim 9 concerns a check-out system with an anti-theft device. Such systems may be found in grocery or hardware stores whereby a store clerk scans the bar code on a product and then deactivates a security tag on the product so the customer can leave the store without setting off any security alarms. The system of claim 9 improves check-out systems because it includes several steps such as (i) examining a product while the product is in a substantially enclosed area; (ii) establishing physical features for the product while it is in the substantially enclosed area (Fig. 6, References 620, 625); and (iii) deactivating the product's security tag while the product is in the substantially enclosed area (Fig. 6, References 620, 645). (Specification, Pg. 9, Lines 1-23; Fig. 7, Reference 710). Thus, the system of claim 9 (i) examines a product; (ii) establishes physical features for the product; and (iii) and deactivates the product tag all while the product is in the substantially enclosed area.

Therefore, because a product is examined, evaluated and deactivated in a substantially enclosed area, theft (*e.g.*, "sweet-hearting") is prevented because a thief is deterred from placing a second product (and likely more expensive product) in the deactivation field along with the product that was properly examined and evaluated.

*Independent Claim 24*

Independent claim 24 provides a check-out system comprising (i) an evaluator for establishing physical features for a product while the product is in a substantially enclosed area (Fig. 6, References 620, 625); and (ii) a deactivation device for deactivating the product security tag while the product is in the substantially enclosed area (Fig. 6, References 620, 645). (Specification, Pg. 9, Lines 1-23; Fig. 7, Reference 710). Thus, the system of claim 24 (i) establishes physical features and (ii) deactivates the product's tag all while the product is in the substantially enclosed area. Therefore, as indicated above when discussing claim 9, theft is deterred.

*Dependent Claim 30*

Dependent claim 30 provides a system depending upon the system described above in claim 24 that comprises a means for ensuring no object is in the substantially enclosed area once the product has been placed in the substantially enclosed area but before the tag has been deactivated. (Specification, Pg. 9, Lines 1-23; Figure 5, Elements 500, 550; Figure 6, Steps 625, 645; Figure 7, Elements 710, 740, 750).

*Dependent Claim 31*

Dependent claim 31 provides a system depending upon the system described above in claim 30 that comprises means for generating an alert signal if an object, in addition to the product, is detected to be in the substantially enclosed area once the product has been placed in the substantially enclosed area but before the tag has been deactivated. (Specification, Pg. 9, Lines 1-23; Figure 3, Element 350).

*Dependent Claim 32*

Dependent claim 32 provides a system depending upon the system described above in claim 31 that comprises means for preventing any deactivation of the tag once the alert signal has been generated. (Specification, Pg. 9, Lines 1-23; Figure 3, Element 350).

**VI. GROUND OF REJECTION TO BE REVIEWED ON APPEAL**

Claims 9-17 and 24-32 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Novak (U.S. Patent No. 5,497,314) in view of Bellis et al. (U.S. Patent Application No. 2003/0024982) (hereinafter "Bellis").

**VII. ARGUMENT**

The Examiner has rejected claims 9-17 and 24-32 under 35 U.S.C. §103(a) as being unpatentable over Novak in view of Bellis. Office Action (11/29/2005), page 3. Appellant respectfully traverses for at least the reasons stated below.

A. Novak and Bellis, taken singly or in combination, do not teach or suggest the limitations of claims 9 and 24.

Appellant respectfully asserts that Novak and Bellis, taken singly or in combination, do not teach or suggest "a check-out method for a product having a security tag associated therewith" as recited in claim 9 and similarly in claim 24. The Examiner cites column 1, line 10 and the Abstract of Novak as teaching the above-cited claim limitation. Office Action (11/29/2005), page 3. Appellant respectfully traverses and asserts that Novak instead teaches that the present invention relates generally to systems and methods of digital image recognition for automatically identifying and categorizing products purchased in retail establishments, such as supermarkets, so that a consumer can 'check-out' the purchased items without the need for store personnel to manually perform this task. Column 1, lines 6-11. Novak

further teaches an automated check-out system for retail stores, such as supermarkets, employing digitized video signals and other means to determine and differentiate individual products, and thereby register the data for billing and inventory purposes. Abstract. Hence, Novak simply teaches systems and methods for automatically identifying and categorizing products. There is no language though in the cited passage that teaches a check-out method for a product having a security tag associated therewith. Therefore, the Examiner has not presented a *prima facie* case of obviousness in rejecting claims 9 and 24, since the Examiner is relying upon an incorrect, factual predicate in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

Appellant further asserts that Novak and Bellis, taken singly or in combination, do not teach or suggest "deactivating said tag with a deactivation device after receipt of said signal and while said product is in said substantially enclosed area" as recited in claim 9 and similarly in claim 24. The Examiner cites paragraph [0040] of Bellis as teaching the above-cited claim limitation. Office Action (11/29/2005), page 5. Appellant respectfully traverses and asserts that Bellis instead teaches that if an item is properly scanned, the electronic-article-surveillance deactivator may be actuated, causing a deactivating coil to be energized and the tag on the item to be deactivated or removed. [0040]. Hence, Bellis teaches deactivating or removing a tag if the item is properly scanned. However, there is no language in the cited passage that teaches deactivating a tag with a deactivation device after receipt of the signal generated if one or more physical characteristics substantially match the one or more physical features. There is no language in the cited passage that teaches the receipt of such a signal. Neither is there any language in the cited passage that teaches deactivating a tag with a deactivation device after receipt of the signal (referring to the signal generated if one or more physical characteristics substantially match the one or more physical features) and while the product is in the

substantially enclosed area. Bellis instead teaches placing an item-shape sensor 600 between the scanning station 110 and the bagging station 270. [0020]; Figures 1-2. Bellis further teaches that any electronic article surveillance deactivator 120, 300 would be located in the scanning station 110 or bagging station 270. [0019]; Figure 1. In short, Bellis provides an item-shape sensor 600, comprising a tunnel, that is located in between the disclosed locations for article surveillance deactivators 120, 300. Hence, Bellis does not teach deactivating a tag with a deactivation device after receipt of the signal (referring to the signal generated if one or more physical characteristics substantially match the one or more physical features) and while the product is in the substantially enclosed area. Therefore, the Examiner has not presented a *prima facie* case of obviousness in rejecting claims 9 and 24, since the Examiner is relying upon an incorrect, factual predicate in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

Furthermore, in connection with the rejection of the above-cited claim limitation, if the Examiner is asserting that Novak teaches a substantially enclosed area and that Bellis teaches the remaining elements of the above-cited claim limitation, Appellant respectfully asserts that Novak and Bellis, taken together, do not teach "deactivating said tag with a deactivation device after receipt of said signal and while said product is in said substantially enclosed area" as recited in claim 9 and similarly in claim 24. Novak instead teaches:

The items are placed on the conveyor by the customer, and are automatically conveyed into an enclosed housing containing an illumination source . . . and video imaging equipment . . . . Digital image processing techniques and technology are used to identify the items by taking a digitized image of the object . . . . By correlating the digital image of each object to additional identification characteristic of the item, a precise determination of proper identity is accomplished. Column 2, lines 13-30.

Thus, Novak teaches an "enclosed housing" 4 (Fig. 1) wherein a product is analyzed. This housing is analogous to the tunnel 602 associated with the item-shape sensor 600 in Bellis (Fig. 2). Consequently, as far as use of a tunnel or housing is concerned, Novak adds little to Bellis.

Put another way, when Bellis contemplated use of a tunnel to analyze a product, any deactivation of security tags took place outside of that tunnel at the scanning station 110 or the bagging station 270. (Bellis, p. 2, ¶ 19-20). Novak is just another example of a housing area used for analysis of a product. In short, neither Bellis nor Novak, nor their combination, consider the deactivation of tags in a substantially enclosed area. In other words, a person of ordinary skill in the art looking at Bellis and/or Novak would appreciate no teaching or suggestion for the element in claim 9 concerning "deactivating said tag . . . while said product is in said substantial enclosed area." The only such teaching or suggestion is found in the Appellant's disclosure. To avoid impermissible hindsight, judgments on obviousness may take into account only knowledge that was in the level of ordinary skill in the art and may not include knowledge gleaned only from the Appellant's disclosure. M.P.E.P. §2145; *In re McLaughlin*, 443 F.2d 1392, 1395 (C.C.P.A. 1971). Hence, Novak and Bellis, taken together, do not teach or suggest deactivating the tag with a deactivation device while the product is in the substantially enclosed area.

Furthermore, there is no language in either Novak or Bellis that teaches deactivating a tag with a deactivation device after receipt of the signal (referring to the signal generated if one or more physical characteristics substantially match the one or more physical features). Hence, Novak and Bellis, taken together, do not teach or suggest deactivating a tag with a deactivation device after receipt of the signal (referring to the signal generated if one or more physical characteristics substantially match the one or more physical features).

Therefore, the Examiner has not presented a *prima facie* case of obviousness in rejecting claims 9 and 24, since the Examiner is relying upon an incorrect, factual predicate in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

Appellant further asserts that Novak and Bellis, taken singly or in combination, do not teach or suggest "a scanner for retrieving from said database said one or more physical characteristics" as recited in claim 24. The Examiner simply states to see the discussion regarding claims 9-14. Office Action (11/29/2005), page 7. However, the Examiner has not cited to any passage in either Novak or Bellis as teaching the above-cited claim limitation. The Examiner bears the initial burden and must submit objective evidence and not rely on his own subjective opinion in support of a *prima facie* case of obviousness. *In re Oetiker*, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992). The Examiner must provide a reference or combination of references that teaches or suggests all of the claim limitations in order to establish a *prima facie* case of obviousness. M.P.E.P. §2143. Since the Examiner has not provided a reference or combination of references that teaches or suggests the above-cited claim limitation, the Examiner has not established a *prima facie* case of obviousness. M.P.E.P. §2143. Therefore, the Examiner has not presented a *prima facie* case of obviousness in rejecting claim 24, since the Examiner is relying upon an incorrect, factual predicate in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

Appellant further asserts that Novak and Bellis, taken singly or in combination, do not teach or suggest "a physical characteristic evaluator for establishing one or more physical features for said product while said product is in said substantially enclosed area" as recited in claim 24. The Examiner simply states to see the discussion regarding claims 9-14. Office Action (11/29/2005), page 7. However, the Examiner has not cited to any passage in either Novak or Bellis as teaching the above-cited claim limitation. The Examiner bears the initial burden and



must submit objective evidence and not rely on his own subjective opinion in support of a *prima facie* case of obviousness. *In re Oetiker*, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992). The Examiner must provide a reference or combination of references that teaches or suggests all of the claim limitations in order to establish a *prima facie* case of obviousness. M.P.E.P. §2143. Since the Examiner has not provided a reference or combination of references that teaches or suggests the above-cited claim limitation, the Examiner has not established a *prima facie* case of obviousness. M.P.E.P. §2143. Therefore, the Examiner has not presented a *prima facie* case of obviousness in rejecting claim 24, since the Examiner is relying upon an incorrect, factual predicate in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

Appellant further asserts that Novak and Bellis, taken singly or in combination, do not teach or suggest "a computer for comparing said one or more physical characteristics to said one or more physical features" as recited in claim 24. The Examiner simply states to see the discussion regarding claims 9-14. Office Action (11/29/2005), page 7. However, the Examiner has not cited to any passage in either Novak or Bellis as teaching the above-cited claim limitation. The Examiner bears the initial burden and must submit objective evidence and not rely on his own subjective opinion in support of a *prima facie* case of obviousness. *In re Oetiker*, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992). The Examiner must provide a reference or combination of references that teaches or suggests all of the claim limitations in order to establish a *prima facie* case of obviousness. M.P.E.P. §2143. Since the Examiner has not provided a reference or combination of references that teaches or suggests the above-cited claim limitation, the Examiner has not established a *prima facie* case of obviousness. M.P.E.P. §2143. Therefore, the Examiner has not presented a *prima facie* case of obviousness in rejecting claim 24, since the Examiner is relying upon an incorrect, factual predicate in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

Appellant further asserts that Novak and Bellis, taken singly or in combination, do not teach or suggest "an electronic circuit for generating a signal if said one or more physical characteristics substantially match said one or more physical features" as recited in claim 24. The Examiner simply states to see the discussion regarding claims 9-14. Office Action (11/29/2005), page 7. However, the Examiner has not cited to any passage in either Novak or Bellis as teaching the above-cited claim limitation. The Examiner bears the initial burden and must submit objective evidence and not rely on his own subjective opinion in support of a *prima facie* case of obviousness. *In re Oetiker*, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992). The Examiner must provide a reference or combination of references that teaches or suggests all of the claim limitations in order to establish a *prima facie* case of obviousness. M.P.E.P. §2143. Since the Examiner has not provided a reference or combination of references that teaches or suggests the above-cited claim limitation, the Examiner has not established a *prima facie* case of obviousness. M.P.E.P. §2143. Therefore, the Examiner has not presented a *prima facie* case of obviousness in rejecting claim 24, since the Examiner is relying upon an incorrect, factual predicate in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

Appellant further asserts that Novak and Bellis, taken singly or in combination, do not teach or suggest "a deactivation device for deactivating said tag after receipt of said signal and while said product is in said substantially enclosed area" as recited in claim 24. The Examiner simply states to see the discussion regarding claims 9-14. Office Action (11/29/2005), page 7. However, the Examiner has not cited to any passage in either Novak or Bellis as teaching the above-cited claim limitation. The Examiner bears the initial burden and must submit objective evidence and not rely on his own subjective opinion in support of a *prima facie* case of obviousness. *In re Oetiker*, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992). The Examiner must provide a reference or combination of references that teaches or

suggests all of the claim limitations in order to establish a *prima facie* case of obviousness. M.P.E.P. §2143. Since the Examiner has not provided a reference or combination of references that teaches or suggests the above-cited claim limitation, the Examiner has not established a *prima facie* case of obviousness. M.P.E.P. §2143. Therefore, the Examiner has not presented a *prima facie* case of obviousness in rejecting claim 24, since the Examiner is relying upon an incorrect, factual predicate in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

B. Claims 10-17 and 25-32 are patentable over Novak in view of Bellis for at least the reasons stated in Section A.

Claims 10-17 depend from claim 9 and hence are patentable over Novak in view of Bellis for at least the reasons that claim 9 is patentable over Novak in view of Bellis as discussed in Section A. Claims 25-32 depend from claim 24 and hence are patentable over Novak in view of Bellis for at least the reasons that claim 24 is patentable over Novak in view of Bellis as discussed in Section A.

C. Claims 15 and 30 are patentable over Novak in view of Bellis.

Appellant respectfully asserts that Novak and Bellis, taken singly or in combination, do not teach or suggest "ensuring no other object is in said substantially enclosed area once said product has been placed in said substantially enclosed area but before said tag has been deactivated" as recited in claim 15 and similarly in claim 30. The Examiner cites column 3, lines 15-20 and lines 30-50 of Novak as teaching the above-cited claim limitation. Office Action (11/29/2005), page 6. Appellant respectfully traverses.

Novak instead teaches that a customer places the objects to be purchased one at a time on the conveyor. Column 3, lines 18-20. This is not the same as ensuring that no other object is in the substantially enclosed area once the product has been placed in the substantially enclosed area as asserted by the Examiner.

Further, Novak instead teaches that it is not essential to the invention to stop the conveyer as long as an 'unblurred' digital image of the object can be obtained. Column 3, lines 38-40. Novak further teaches that a second sensor can be used if desired to increase the accuracy of the distance of travel of the object. Column 3, lines 40-42. Novak further teaches that a digital imaging camera of a known focal length and field of view is positioned so that the object to be identified is now located within the focal plane of the camera. Column 3, lines 49-51. Hence, Novak teaches identifying an object within a housing using a digital imaging camera.

There is no language in the cited passages that teaches ensuring no other object is in the substantially enclosed area once the product has been placed in the substantially enclosed area. In fact, as illustrated in Figure 1 of Novak, it appears that quite easily multiple objects could be placed in housing 4 at one time. Novak even specifically teaches that multiple items may be in housing 4 at one time. Novak teaches that the system may not be able to identify a specific item because two items are on the conveyor. Column 7, lines 57-59. Further, there is no language in the cited passages that teaches ensuring no other object is in the substantially enclosed area once the product has been placed in the substantially enclosed area but before the tag has been deactivated. Therefore, the Examiner has not presented a *prima facie* case of obviousness in rejecting claims 15 and 30, since the Examiner is relying upon an incorrect, factual predicate in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

D. Claims 16 and 31 are patentable over Novak in view of Bellis.

Appellant respectfully asserts that Novak and Bellis, taken singly or in combination, do not teach or suggest "generating an alert signal if an object, in addition to said product, is detected to be in said substantially enclosed area once said product has been placed in said substantially enclosed area but before said tag has

been deactivated" as recited in claim 16 and similarly in claim 31. The Examiner cites column 7, line 55 – column 8, line 10 of Novak as teaching the above-cited claim limitation. Office Action (11/29/2005), page 6. Appellant respectfully traverses.

Novak instead teaches that if for some reasons the system cannot identify a specific item or if a timer is used to indicate that a predetermined amount of time has elapsed for the object identification to take place, the conveyor is started and moves the object(s) to the bagging area. Column 7, lines 57-62. Novak further teaches that in this case, the digital image can be converted to video and a direct video signal depicting the object is forwarded to the central station along with data, such as the product name, UPC number and video image for the subset of objects from which the object belongs. Column 7, lines 62-67. Novak further teaches that the cashier or other authorized person, can choose the item in question from the data provided on the subset of items to quickly, easily and accurately resolve the issue rather than requiring manual intervention or direct primary information on the object. Column 7, line 67 – column 8, line 4. Hence, Novak teaches the cashier or authorized person quickly resolving why the system cannot identify a specific item or why time has elapsed for the object identification to take place.

There is no language in the cited passage that teaches generating an alert signal. Neither is there any language in the cited passage that teaches generating an alert signal if an object, in addition to the product, is detected to be in the substantially enclosed area once the product has been placed in said substantially enclosed area. Instead, Novak simply teaches that the conveyor is started and moves the object(s) to the bagging area. Neither is there any language in the cited passage that teaches generating an alert signal if an object, in addition to the product, is detected to be in the substantially enclosed area once the product has been placed in said substantially enclosed area but before the tag has been deactivated. Therefore,

the Examiner has not presented a *prima facie* case of obviousness in rejecting claims 16 and 31, since the Examiner is relying upon an incorrect, factual predicate in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

E. Claims 17 and 32 are patentable over Novak in view of Bellis.

Appellant respectfully asserts that Novak and Bellis, taken singly or in combination, do not teach or suggest "preventing any deactivation of said tag once said alert signal has been generated" as recited in claim 17 and similarly in claim 32. The Examiner cites column 7, line 55 – column 8, line 10 of Novak as teaching the above-cited claim limitation. Office Action (11/29/2005), page 6. Appellant respectfully traverses. As stated above, Novak instead teaches the cashier or authorized person quickly resolving why the system cannot identify a specific item or why time has elapsed for the object identification to take place. There is no language in the cited passage that teaches preventing any deactivation of a tag. Neither is there any language in the cited passage that teaches preventing any deactivation of a tag once an alert signal has been generated. Therefore, the Examiner has not presented a *prima facie* case of obviousness in rejecting claims 17 and 32, since the Examiner is relying upon an incorrect, factual predicate in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

F. The Examiner's motivation to modify Novak to include the limitation of "deactivating said tag with a deactivation device after receipt of said signal and while said product is in said substantially enclosed area", as recited in claims 9 and 24, is insufficient to establish a *prima facie* case of obviousness.

Most if not all inventions arise from a combination of old elements. See *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1457 (Fed. Cir. 1998). Obviousness is determined from the vantage point of a hypothetical person having ordinary skill in the art to which the patent pertains. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1457 (Fed. Cir. 1998). Therefore,

an Examiner may often find every element of a claimed invention may often be found in the prior art. *Id.* However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. *See Id.* In order to establish a *prima facie* case of obviousness, the Examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1458 (Fed. Cir. 1998). That is, the Examiner must provide some suggestion or motivation, either in the references themselves, the knowledge of one of ordinary skill in the art, or, in some case, the nature of the problem to be solved, to modify the reference or to combine reference teachings. *See In re Dembiczak*, 175 F.3d 994, 999, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999). Whether the Examiner relies on an express or an implicit showing, the Examiner must provide particular findings related thereto. *In re Kotzab*, 55 U.S.P.Q.2d 1313, 1317 (Fed. Cir. 2000).

The Examiner admits that Novak does not teach "deactivating said tag with a deactivation device after receipt of said signal and while said product is in said substantially enclosed area" as recited in claim 9 and similarly in claim 24. Office Action (11/29/2005), page 5. The Examiner's motivation for modifying Novak with Bellis to include the above-cited missing claim limitation "because in many stores, and particularly clothing stores, products have security tags that must be deactivated during a purchasing transaction." Office Action (11/29/2005), page 6. The Examiner's motivation is insufficient to support a *prima facie* case of obviousness for at least the reasons stated below.

As stated above, in order to establish a *prima facie* case of obviousness, the Examiner must provide some suggestion or motivation, either in the references themselves, the knowledge of one of ordinary skill in the art, or, in some cases the nature of the problem to be solved, to modify the reference or to combine reference

teachings. *See In re Dembiczak*, 175 F.3d 1994, 999, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999). The Examiner has not provided any evidence that his motivation comes from any of these sources. Instead, the Examiner is relying upon his own subjective opinion which is insufficient to support a *prima facie* case of obviousness. *In re Lee*, 61 U.S.P.Q.2d 1430, 1434 (Fed. Cir. 2002). Consequently, the Examiner's motivation is insufficient to support a *prima facie* case of obviousness for rejecting claims 9-17 and 24-32. *Id.*

Further, the Examiner's motivation ("because in many stores, and particularly clothing stores, products have security tags that must be deactivated during a purchasing transaction") does not provide reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would modify Novak to deactivate a tag with a deactivation device after receipt of the signal (referring to the signal generated if one or more physical characteristics substantially match the one or more physical features) while the product is in the substantially enclosed area. Novak addresses the problem of developing an automated check-out of retail items that is not dependent upon the involvement of the customer or store personnel and that does not rely principally upon bar code technology. Column 1, line 66 – column 2, line 7. The Examiner has not provided any reasons as to why one skilled in the art would modify Novak (Novak teaches automatically checking out retail items that is not dependent upon the involvement of the customer or store personnel and that does not rely principally upon bar code technology) to include a tag on a product and then deactivate that tag with a deactivation device after receipt of the signal while the product is in the substantially enclosed area (Examiner admits that Novak does not teach this limitation). The Examiner's motivation ("because in many stores, and particularly clothing stores, products have security tags that must be deactivated during a purchasing transaction") does not provide any reasons that the skilled artisan would modify Novak in such a manner. Accordingly, the Examiner has not presented a



*prima facie* case of obviousness for rejecting claims 9-17 and 24-32. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1458 (Fed. Cir. 1998).

- G. The Examiner has failed to establish a *prima facie* case of obviousness in rejecting claim 24 since the Examiner failed to provide a motivation for modifying Novak to include the limitation of "a database for storing one or more physical characteristics for said product", as recited in claim 24.

As stated above, most if not all inventions arise from a combination of old elements. *See In re Rouffet*, 47 U.S.P.Q.2d 1453, 1457 (Fed. Cir. 1998). Obviousness is determined from the vantage point of a hypothetical person having ordinary skill in the art to which the patent pertains. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1457 (Fed. Cir. 1998). Therefore, an Examiner may often find every element of a claimed invention may often be found in the prior art. *Id.* However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. *See Id.* In order to establish a *prima facie* case of obviousness, the Examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1458 (Fed. Cir. 1998). That is, the Examiner must provide some suggestion or motivation, either in the references themselves, the knowledge of one of ordinary skill in the art, or, in some case, the nature of the problem to be solved, to modify the reference or to combine reference teachings. *See In re Dembiczak*, 175 F.3d 994, 999, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999). Whether the Examiner relies on an express or an implicit showing, the Examiner must provide particular findings related thereto. *In re Kotzab*, 55 U.S.P.Q.2d 1313, 1317 (Fed. Cir. 2000).

The Examiner admits that Novak does not teach "a database for storing one or more physical characteristics for said product" as recited in claim 24. Office Action

(11/29/2005), page 7. The Examiner asserts that Bellis teaches such a database in paragraph [0019]. Office Action (11/29/2005), page 7. However, the Examiner has not provided any motivation for modifying Novak with Bellis. As stated above, the Examiner must provide a motivation or suggestion to modify the reference or to combine reference teachings. *See In re Dembiczak*, 175 F.3d 994, 999, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999). Since the Examiner has not provided any motivation for modifying Novak with Bellis, the Examiner has not presented a *prima facie* case of obviousness in rejecting claims 24-32. M.P.E.P. §2143.

- H. The Examiner has failed to establish a *prima facie* case of obviousness in rejecting claim 24 to the extent that the Examiner relies upon Bellis to teach the claim limitations in claim 24 and has not provided motivation for modifying Novak to include such limitations.

The Examiner simply states in his rejection of claim 24 to see the discussion regarding claims 9-14. Office Action (11/29/2005), page 7. However, the claim limitations in claim 24 are not identical to the claim limitations in claim 9 and hence there are several claim limitations that were not addressed by the Examiner. If the Examiner asserts that any of these claim limitations are taught by Bellis, then the Examiner must provide motivation for modifying Novak with Bellis to include such claim limitations in order to establish a *prima facie* case of obviousness. *See In re Dembiczak*, 175 F.3d 994, 999, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999). Hence, if the Examiner does indeed assert that any of these claim limitations in claim 24 are taught by Bellis, then the Examiner has failed to establish a *prima facie* case of obviousness in rejecting claim 24 since the Examiner has not provided any motivation for modifying Novak to include such missing claim limitations. *Id.*

- I. The Examiner's motivation to modify Novak to include a missing claim limitation in claims 13 and 28 is insufficient to establish a *prima facie* case of obviousness.

As stated above, most if not all inventions arise from a combination of old

elements. *See In re Rouffet*, 47 U.S.P.Q.2d 1453, 1457 (Fed. Cir. 1998). Obviousness is determined from the vantage point of a hypothetical person having ordinary skill in the art to which the patent pertains. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1457 (Fed. Cir. 1998). Therefore, an Examiner may often find every element of a claimed invention may often be found in the prior art. *Id.* However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. *See Id.* In order to establish a *prima facie* case of obviousness, the Examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1458 (Fed. Cir. 1998). That is, the Examiner must provide some suggestion or motivation, either in the references themselves, the knowledge of one of ordinary skill in the art, or, in some case, the nature of the problem to be solved, to modify the reference or to combine reference teachings. *See In re Dembiczak*, 175 F.3d 994, 999, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999). Whether the Examiner relies on an express or an implicit showing, the Examiner must provide particular findings related thereto. *In re Kotzab*, 55 U.S.P.Q.2d 1313, 1317 (Fed. Cir. 2000).

The Examiner admits that Novak does not teach "wherein said one or more physical characteristics and said one or more physical features pertain to color" as recited in claim 13 and similarly in claim 28. Office Action (11/29/2005), page 6. The Examiner's motivation for modifying Novak with Bellis to include the above-cited missing claim limitation "because the system can arrive more quickly and accurately at identification of a product." Office Action (11/29/2005), page 6. The Examiner's motivation is insufficient to support a *prima facie* case of obviousness for at least the reasons stated below.

As stated above, in order to establish a *prima facie* case of obviousness, the

Examiner must provide some suggestion or motivation, either in the references themselves, the knowledge of one of ordinary skill in the art, or, in some cases the nature of the problem to be solved, to modify the reference or to combine reference teachings. *See In re Dembiczak*, 175 F.3d 1994, 999, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999). The Examiner has not provided any evidence that his motivation comes from any of these sources. Instead, the Examiner is relying upon his own subjective opinion which is insufficient to support a prima facie case of obviousness. *In re Lee*, 61 U.S.P.Q.2d 1430, 1434 (Fed. Cir. 2002). Consequently, the Examiner's motivation is insufficient to support a *prima facie* case of obviousness for rejecting claims 13 and 28. *Id.*

VIII. CONCLUSION

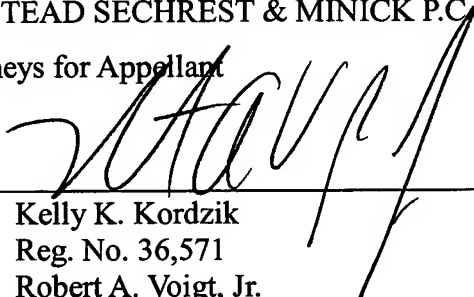
For the reasons noted above, the rejections of claims 9-17 and 24-32 are in error. Appellant respectfully requests reversal of the rejections and allowance of claims 9-17 and 24-32.

Respectfully submitted,

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## CLAIMS APPENDIX

1       9.     A check-out method for a product having a security tag associated therewith,  
2       comprising the steps of:

3             storing one or more physical characteristics for said product;  
4             recalling said one or more physical characteristics when a consumer checks  
5       out said product;

6             placing said product in a substantially enclosed area;  
7             examining said product while said product is in said substantially enclosed  
8       area;

9             establishing one or more physical features for said product while said product  
10       is in said substantially enclosed area;

11            comparing said one or more physical characteristics to said one or more  
12       physical features;

13            generating a signal if said one or more physical characteristics substantially  
14       match said one or more physical features; and

15            deactivating said tag with a deactivation device after receipt of said signal and  
16       while said product is in said substantially enclosed area.

1       10.    The method according to claim 9 wherein said one or more physical  
2       characteristics and said one or more physical features pertain to weight.

1       11.    The method according to claim 9 wherein said one or more physical  
2       characteristics and said one or more physical features pertain to size.

1       12.    The method according to claim 9 wherein said one or more physical  
2       characteristics and said one or more physical features pertain to shape.

1       13.    The method according to claim 9 wherein said one or more physical  
2       characteristics and said one or more physical features pertain to color.

1 14. The method according to claim 9 wherein said one or more physical  
2 characteristics and said one or more physical features pertain to two or more of the  
3 following: weight, size, shape, color or surface texture.

1 15. The method according to claim 9 further comprising the step of ensuring no  
2 other object is in said substantially enclosed area once said product has been placed in  
3 said substantially enclosed area but before said tag has been deactivated.

1 16. The method according to claim 15 further comprising the step of generating  
2 an alert signal if an object, in addition to said product, is detected to be in said  
3 substantially enclosed area once said product has been placed in said substantially  
4 enclosed area but before said tag has been deactivated.

1 17. The method according to claim 16 further comprising the step of preventing  
2 any deactivation of said tag once said alert signal has been generated.

1 24. A check-out system for a product having a security tag associated therewith,  
2 comprising:

3 a substantially enclosed area;

4 a database for storing one or more physical characteristics for said product;

5 a scanner for retrieving from said database said one or more physical  
6 characteristics;

7 a physical characteristic evaluator for establishing one or more physical  
8 features for said product while said product is in said substantially enclosed area;

9 a computer for comparing said one or more physical characteristics to said one  
10 or more physical features;

11 an electronic circuit for generating a signal if said one or more physical  
12 characteristics substantially match said one or more physical features; and

13 a deactivation device for deactivating said tag after receipt of said signal and  
14 while said product is in said substantially enclosed area.

1 25. The system according to claim 24 wherein said one or more physical  
2 characteristics and said one or more physical features pertain to weight.

1 26. The system according to claim 24 wherein said one or more physical  
2 characteristics and said one or more physical features pertain to size.

1 27. The system according to claim 24 wherein said one or more physical  
2 characteristics and said one or more physical features pertain to shape.

1 28. The system according to claim 24 wherein said one or more physical  
2 characteristics and said one or more physical features pertain to color.

1 29. The system according to claim 24 wherein said one or more physical  
2 characteristics and said one or more physical features pertain to two or more of the  
3 following: weight, size, shape, color or surface texture.

1 30. The system according to claim 24 further comprising a means for ensuring no  
2 other object is in said substantially enclosed area once said product has been placed in  
3 said substantially enclosed area but before said tag has been deactivated.

1 31. The system according to claim 30 further comprising means for generating an  
2 alert signal if an object, in addition to said product, is detected to be in said  
3 substantially enclosed area once said product has been placed in said substantially  
4 enclosed area but before said tag has been deactivated.

1 32. The system according to claim 31 further comprising means for preventing  
2 any deactivation of said tag once said alert signal has been generated.



**EVIDENCE APPENDIX**

No evidence was submitted pursuant to §§1.130, 1.131, or 1.132 of 37 C.F.R. or of any other evidence entered by the Examiner and relied upon by Appellant in the Appeal.

**RELATED PROCEEDINGS APPENDIX**

There are no related proceedings to the current proceeding.

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7036-P255US 1/26/2006



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Remarks

2nd Appeal Brief

### SIGNATURE OF APPLICANT/ATTORNEY, OR AGENT

Firm or Individual name	Winstead Sechrest & Minick P.C. Robert A. Voigt, Jr. : Reg. No. 47,159
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